

## **REMARKS**

### **Power of Attorney**

The subject file has recently been transferred to the undersigned for prosecution. Please process the enclosed Power of Attorney by Assignee of Entire Interest and direct all future communications to the undersigned. Please also associate this application with Customer Number 34205.

### **Status of Claims**

Claims 1-17, 19-28, and 36-44 are pending in the application. Claims 1-17, 19-28, and 36-44 are rejected. With this Amendment, Applicant has canceled dependent claim 22 without prejudice and amended independent claim 1.

### **Rejection under 35 U.S.C. §102**

The Examiner rejected claims 23-28 and 36-44 under 35 U.S.C. §102(b) as being anticipated by Ingle et al. ("Ingle"), U.S. Patent 6,091,995. In order to reject a claim under 35 U.S.C. §102 as being anticipated by the prior art, each element of the claim under construction must be disclosed in a single prior art reference. In re Dillon, 919 F.2d 688, 16 U.S.P.Q.2d 1897, 1908 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991).

In rejecting independent claim 23, the Examiner stated that Ingle discloses a system for treating incontinence comprising "a probe body" and "at least one energy delivery element." Claim 23 recites a system for treating incontinence comprising "a probe body alignable with the collagenous pelvic tissue" and "at least one energy delivery element supported by the probe body, the at least one energy delivery element capable of heating, from the aligned probe body, a treatment volume of at least 300 cubic millimeters of the collagenous tissue." Accordingly, the present invention is not anticipated because Ingle does not disclose "a treatment volume of at least 300 cubic millimeters" as claimed by Applicant.

The Examiner has taken the position that the system of Ingle is inherently capable of heating, from the aligned probe body, a treatment volume between about 300 cubic millimeters and about 800 cubic millimeters. (Office Action of June 29, 2006, page 4.) To support his position, the Examiner provided an example of a calculated treatment volume of about 640 cubic millimeters, which is admittedly above the "at least 300 cubic millimeters" recited in independent claim 23. (See Office Action of June 29, 2006, page 6.) However, the example provided by the Examiner is not consistent with the disclosure of Ingle.

According to the Examiner, "if the electrode diameter is 4 mm and the separation is 3 times that or 12 mm, then the approximate cross sectional area would be 80 sq. mm and with a depth of **2 times** the electrode surface diameter (about 8 mm), the treatment volume would be about 640 cu. mm." However, a depth of **2 times** the electrode diameter (or about 8mm in the Examiner's example) is not within the scope of the disclosure provided by Ingle. In particular, Ingle discloses a maximum electrode surface diameter of about 4.0 millimeters, a maximum electrode pair spacing of about 4.0 times the electrode surface diameter, and a maximum treatment depth of about 2.8 millimeters. (See Col. 4, lines 35-50 and Col. 13, lines 31-43.) Thus, a depth of 8 millimeters (2 times an electrode surface diameter of 4.0 millimeters) is not within the about 2.8 millimeter maximum depth disclosed by Ingle.

Based upon the maximum values of electrode surface diameter, spacing, and depth disclosed by Ingle, it is not possible to achieve a "treatment volume of at least 300 cubic millimeters" with the Ingle system. Modifying the Examiner's example with the correct maximum values, if the electrode diameter is 4.0 millimeters, the separation is 4.0 times the electrode diameter (or about 16.0 millimeters), and the depth is about 2.8 millimeters, then the treatment volume would be about 268.8 cubic millimeters, which is less than the "at least 300 cubic millimeters" required by independent claim 23. Because Ingle fails to disclose each element of independent claim 23, the rejection of claim 23 under 35 U.S.C. §102 should be withdrawn.

Dependent claims 24-28 and 36-44 were also rejected under 35 U.S.C. §102(b) as being anticipated by Ingle. Claims 24-28 and 36-44 depend from independent claim 23. As such, these

claims are allowable with their independent base claim. In addition, it is respectfully submitted that the combinations of features recited in claims 24-28 and 36-44 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Rejection under 35 U.S.C. §103

The Examiner rejected claims 1-17 and 19-22 under 35 U.S.C. §103(a) as being unpatentable over Ingle et al. ("Ingle"), U.S. Patent 6,091,995. In order to reject a claim under 35 U.S.C. §103 as being obvious over the prior art, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. 2143.03, citing In re Royka, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

In rejecting independent claim 1, the Examiner stated that Ingle discloses a system for treating incontinence comprising "aligning a probe body" and "heating a treatment volume of approximately 100 cubic millimeters" of the collagenous tissue. With this Amendment, independent claim 1 has been amended to recite a method for treating incontinence comprising "aligning a probe body with a collagenous pelvic tissue" and "heating a treatment volume between about 100 and about 800 cubic millimeters of the collagenous tissue using the aligned probe body." Based upon the above discussion in response to the rejection of independent claim 23, Ingle does not teach or suggest a system capable of heating a treatment volume from about 100 cubic millimeters up to about 800 cubic millimeters of collagenous tissue. Because Ingle fails to teach or suggest each element of independent claim 1, the reference does not render claim 1 obvious. Therefore, the rejection of independent claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Dependent claims 2-17 and 19-22 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Ingle. With this Amendment, claim 22 has been canceled without prejudice. Claims 2-17 and 19-21 depend from amended independent claim 1. As such, these claims are allowable with their independent base claim. In addition, it is respectfully submitted that the combinations of features recited in claims 2-17 and 19-21 are patentable on their own merits,

although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

**Conclusion**

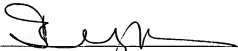
Applicant respectfully submits that with the arguments and amendments presented herein all pending claims are allowable over the art of record, for at least the reasons discussed above, and respectfully requests that a Notice of Allowance with respect to all pending claims be issued in this case.

If the Examiner believes that a teleconference would be of further value in expediting the allowance of the pending claims, the undersigned can be reached at the telephone number listed below. The present response is being filed within the three-month statutory period for response (on or before September 29, 2006), and no fee or petition for an extension is due. If, however, it is believed that any additional fees are necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference #687-3101/US).

Dated: September 29, 2006

Respectfully submitted,

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